

Application No. : 09/890,366
Filing Date : July 26, 2001
Reply To Office
Action Dated : November 23, 2004

REMARKS

The foregoing amendments to the claims are responsive to the October 8, 2004 Office Action in which the Examiner rejects Claims 6-14 and under 35 U.S.C. §112, second paragraph, and Claims 1 and 6-14 under 35 U.S.C. §112, first paragraph. As discussed more fully below, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 112, first and second paragraphs.

Discussion of the Amendments

By the foregoing amendments, Applicants have Amended Claims 1 and 12-14 and have canceled Claims 6-8 without prejudice or disclaimer. No new matter is introduced by the amendments of Claims 1 and 12-14 or the addition of new Claims 15 and 16. Additionally, Applicants submit that all of the amendments place the present application in better condition for appeal, do not raise new issues, and/or make the outstanding rejections moot.

Claims 6-14 Fully Comply With 35 U.S.C. § 112

The Examiner rejected Claims 6-14 as being indefinite under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse the present rejections. However, in order to expedite prosecution of the present application, Applicants have amended Claims 12-14 solely to make these claims more easily readable and not to narrow or affect the scope of this claim. Additionally, also to expedite prosecution of the present application, Claims 6-8 have been canceled without prejudice or disclaimer, and thus, the rejections of these claims are now moot.

In response to the rejection of Claim 12 based on the recitation of "at least one of other aggregates and particle nuclei" Applicant submits that this format of alternative language has long been widely used and accepted by the patent office. A full text search of claims in issued U.S. patents for the term "at least one of" (easily performed on the U.S. Patent Office web site) yields **1,023,886**

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hits. A brief review of these hits reveals that the term "at least one of" is commonly used in the format "at least one of A and B." This format is commonly used to claim elements in a way that means A and/or B, resulting in the following 3 alternatives: (1) A, (2) B, and (3) A and B.

In any event, in order to expedite prosecution of the present Application, Applicant has deleted the term "at least one of other aggregates and particle nuclei." Thus, this rejection is now moot.

In response to the rejection of Claim 12 based on the phrase "past of the laser beam", Applicant has deleted the term "of". Applicant submits that this change was contemplated by the Examiner at page 3 of the Office Action. Additionally, the Examiner assumed this correction in the rejection of Claim 12 under 35 U.S.C. § 112, first paragraph (discussed below).

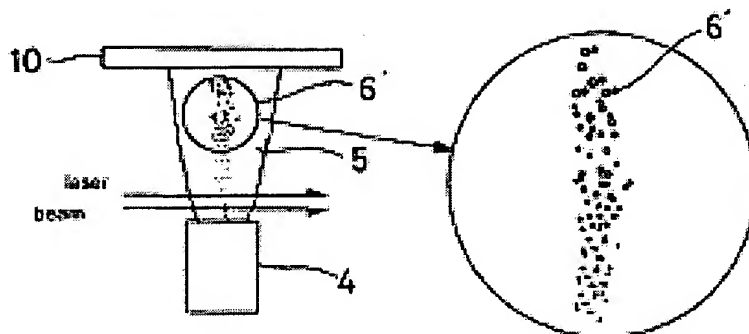
In response to the rejection of Claim 14 based on the lack of antecedent basis for the term "the position", Applicant has amended Claim 14 to recite "a position."

With regard to the rejection of Claims 1 and 6-14 under 35 U.S.C. § 112, first paragraph, Applicant respectfully traverses the present rejection.

In response to the rejection of Claim 1, based on the recitation of "where the aggregates start being formed," Applicant submits that this phrase is clearly supported by the present Application at page 8, lines 5-7, where the specification discloses "irradiating a laser beam in the wavelength range in which particles readily absorb the laser beam into the tiny aggregates at an early **initial aggregation stage...**" (Emphasis added). However, in order to expedite prosecution of the present Application, Applicant has canceled the phrase "where the aggregates start being formed," and has also canceled Claim 8. This phrase has been added into new Claim 15. Additionally, new Claim 16 has been added, which recites the phrase "early initial aggregation stage."

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In response to the rejection of Claim 12 based on the recitation that the "aggregates flow past the laser beam," Applicant submits that the non-limiting embodiment of Figure 5 (reproduced



adjacently hereto) clearly illustrates that particles 6' flow past the laser beam. The specification at page 8, lines 22-23 discloses that "the particles become much smaller-sized spherical particles (6' of FIG. 5) compared to those (6 of FIG. 4) without laser incidence."

Unamended Claim 12 recited "so as to fuse said aggregates." Claim 12 has been amended to add a label to these aggregates that are fused; now referred to as "fused aggregates." This label is merely used for clarity and to make Claim 12 more easily understandable. These fused aggregates are referred to as "fine particles" in Claim 1, and are also referred to as "much smaller-sized spherical particles" in the specification at page 8, line 22-23.

Additionally, the term "fused" was used in unamended Claim 1 without objection from the Examiner. Thus, Applicant reasonably assumes that there should not be any objection to the continued use of the term "fuse." Applicant thus submits that one of ordinary skill in the art would clearly understand that the fused aggregates now recited in Claim 12 are fused in the laser beam and flow upwardly past the laser beam toward the substrate 10. Thus, Applicant submits that Claim 12 is clearly supported by the present specification.

Finally, with respect to the rejection of the claims based on the phrase "collecting," Applicant has amended Claims 13 and 14 to recite "the fused

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aggregates” and “said fused aggregates,” respectively. Applicants submit that one of ordinary skill in the art would understand from the present specification that the “fused aggregates” recited in Claim 12 are aggregates that have been fused by the laser; where such fused aggregates are referred to as “fine particles” in Claim 1, and “much smaller-sized spherical particles” in the specification at page 8, line 22-23. Thus, Claims 13 and 14 are fully supported by the present specification.

Response to Request for Information Under 37 CFR § 1.105

In response to the request for information under 37 CFR § 1.105, Applicants have submitted herewith copies of some of the articles cited in the Background of the specification of the present Application. The IDS submitted herewith includes the full citations of those articles, as does the Background section of the present Application. Further, with respect to the articles included in the IDS submitted herewith, the Background section of the present Application includes a detailed description of the relevance of these articles. Thus, Applicants submit that no further explanation of the relevance of these articles is necessary.

With respect to the Examiner’s request for “each publication that is a source used for the description of the prior art in the disclosure,” Applicant submits this request is overly burdensome. However, in a good faith effort to comply with the Examiner’s request, Applicant has submitted information that was readily available. In fact, Applicants have submitted herewith all but one of the articles cited in the Background section.

Further, with respect to the Examiner’s request for a “concise explanation of that publication’s contribution to the *description* of the prior art,” (emphasis added) Applicants submit that there is no rule in the MPEP that allows an

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Examiner to request such an explanation. Rather, the basis for a Rule 105 request lies in the Examiner's ability to determine the patentability of the claims. The explanations of the relevance of the articles included with the IDS submitted herewith that are already set forth in the Background section of the present Application fully explain the relevance of these publications. If the Examiner was referring to a basis of patentability other than those addressed in 35 U.S.C. §§ 102, and 103, Applicants respectfully request the Examiner to clearly explain such bases.

To the extent that the information submitted herewith in response to the present request for information does not satisfy the Examiner's request, then Applicants submit that the information to be submitted is unknown or is not readily available to the party or parties from which it was requested. See MPEP § 704.12(b). Thus, Applicants submit that the outstanding request is satisfied.

Request For Telephone Interview

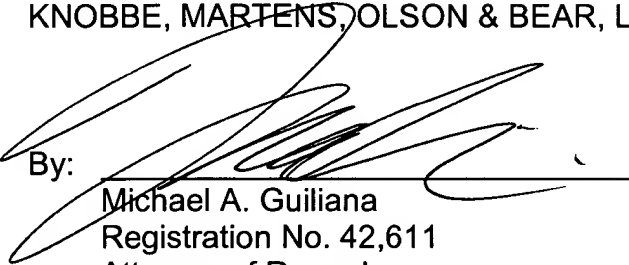
In view of the forgoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, Applicants' undersigned attorney of record hereby formally requests a telephone interview with the Examiner. Applicants

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respectfully request the Examiner to call the undersigned attorney of record at 949-721-6384 (direct) or at the general office number listed below.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/23/05

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